

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

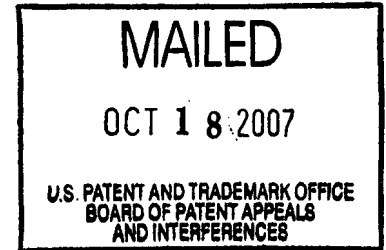
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Ex parte ROBERT E. HAINES  
AND JUDITH A. GARZOLINI

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Application No. 09/981,117

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ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

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This application was electronically received at the Board of Patent Appeals and Interferences (BPAI) on August 22, 2007. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is wherewith being returned to the examiner. The matter requiring attention prior to docketing is identified below.

APPEAL BRIEF

On June 7, 2006, Appellants filed an Appeal Brief. A review of the file reveals that the "Summary of Claimed Subject Matter" does not map each of the independent claims to the specification. Further, regarding claim 12, Appellants must provide support for the "means" for language, as set forth in 37 C.F.R.

§ 41.37(c)(1)(v) which states:

(v) *Summary of claimed subject matter.* A concise explanation of the subject matter defined in each of the independent claims involved in the appeal, which shall refer to the specification by page and line number, and to the drawing, if any, by reference characters. For **each independent claim** involved in the appeal and for each dependent claim argued separately under the provisions of paragraph (c)(1)(vii) of this section, **every means plus function and step plus function as permitted by 35 U.S.C. 112, sixth paragraph, must be identified and the structure, material, or acts described in the specification as corresponding to each** claimed function must be set forth with reference to the specification by page and line number, and to the drawing, if any, by reference characters.

Proper correction of the Appeal Brief is required.

When the Office holds the brief to be defective solely due to appellant's failure to provided a summary of the claimed subject matter as required by 37 C.F.R. § 41.37(c)(1)(v), an entire new brief need not, and should not be filed. Rather, a paper providing a summary of the claimed subject matter as required by 37 C.F.R. § 41.37(c)(1)(v) will suffice. Failure to timely respond to the Office's requirement will result in dismissal of the appeal. See MPEP § 1215.04 and § 711.02(b).

In addition, claim 9, in the Appeal Brief filed on June 7, 2006, is indicated as under Appeal in "Status of the Claims", however the claim is not listed under "Grounds of rejection to be reviewed on Appeal" or under the "Argument" sections.

37 C.F.R. § 41.37(c) states in part:

(c)(1) The brief shall contain the following items under appropriate headings and in the order indicated in paragraphs (c)(1)(I) through (c)(1)(x) of this section, except that a brief filed by an appellant who is not represented by a registered practitioner need only substantially

comply with paragraphs (c)(1)(I) through (c)(1)(iv) and (c)(1)(vii) through (c)(1)(x) of this section:

(vi) *Grounds of rejection to be reviewed on appeal.* A concise statement of each ground of rejection presented for review.

(vii) *Argument.* The contentions of appellant with respect to each ground of rejection presented for review in paragraph (c)(1)(vi) of this section, and the basis therefor, with citations of the statutes, regulations, authorities, and parts of the record relied on. Any arguments or authorities not included in the brief or a reply brief filed pursuant to § 41.41 will be refused consideration by the Board, unless good cause is shown. Each ground of rejection must be treated under a separate heading. For each ground of rejection applying to two or more claims, the claims may be argued separately or as a group. When multiple claims subject to the same ground of rejection are argued as a group by appellant, the Board may select a single claim from the group of claims that are argued together to decide the appeal with respect to the group of claims as to the ground of rejection on the basis of the selected claim alone. Notwithstanding any other provision of this paragraph, the failure of appellant to separately argue claims which appellant has grouped together shall constitute a waiver of any argument that the Board must consider the patentability of any grouped claim separately. Any claim argued separately should be placed under a subheading identifying the claim by number. Claims argued as a group should be placed under a subheading identifying the claims by number. A statement which merely points out what a claim recites will not be considered an argument for separate patentability of the claim.

It is required that a Supplemental Appeal Brief be submitted that is in compliance with 37 CFR § 41.37(c).

**EXAMINER'S ANSWER**

On May 21, 2007, an Examiner Answer was mailed. In the section entitled Evidence Relied Upon (pg. 2) the Examiner stated that "No evidence is relied upon by the examiner in the rejection of the claims under appeal." A review of the file reveals that references to Arima U.S. 6,714,744 and Gonnella, Jr. U.S. 6,577,825 were applied to the statement of rejections in the Grounds of Rejection, paragraph (9) of the Examiner's Answer. Before further review, the Examiner must mail a PTOL-90 that will include in the amended Evidence Relied Upon section, the list of references mentioned in the statement of rejections. See the Manual of Patent Examining Procedure, (MPEP) §1207.02. Appropriate correction is required.

**CONCLUSION**

Accordingly, it is ORDERED that the application is returned to the Examiner:

- 1) to hold the Appeal Brief filed on June 7, 2006, defective;
- 2) notify Appellants to file a supplemental Appeal Brief providing a Summary of the Claimed Subject Matter as required by 37 C.F.R. § 41.37(c)(1)(v), and properly addressing claim 9;

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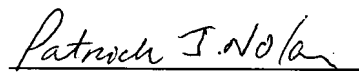
- 3) to consider the Supplemental Appeal Brief, and if necessary vacate the Examiner's Answer and supply a new Examiner's Answer in response which includes an amended Evidence relied upon section;

Or,

issue and mail a PTOL-90 citing all references relied on in the rejection of the claims on appeal; and

- 4) for such further action as may be deemed appropriate.

BOARD OF PATENT APPEALS  
AND INTERFERENCES



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